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In re Application of
Allen W. THORPE et al.
Application No.: 09/463,001
PCT No.: PCT/US98/14775
Int. Filing Date: 16 July 1998
Priority Date: 17 July 1997
Attorney's Docket No.: 7387
For: THERMAL PROTECTIVE STRUCTURES
AND METHODS OF MAKING THEM

:
: DECISION ON
:
: PETITION
:
: UNDER 37 CFR 1.48(b)
:
:

This is a decision in response to the petition filed under 37 CFR 1.48(b) on 18 January 2000, to delete inventor Malkit S. DEOGON. The requisite petition fee under 37 CFR 1.17(I) of \$130.00 has been received.

BACKGROUND

On 16 July 1998, applicants filed international application PCT/US98/14775, which claimed priority of earlier U.S. application 08/895,918, filed 17 July 1997. A Demand for international preliminary examination, in which the United States was elected, was filed on 05 February 1999. Accordingly, the thirty month period for paying the basic national fee in the United States expired at midnight on 18 January 2000 (17 January 2000 being a Federal holiday).

On 18 January 2000, applicants filed a Transmittal Letter for entry into the national stage in the United States under 35 U.S.C. 371, accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1), a declaration of inventors Thorpe, Taylor, and Feldman, as required by 35 U.S.C. 371(c)(4), a preliminary amendment, a petition to remove an inventor, and a petition fee of \$130.00.

DISCUSSION

The present national stage application must first be executed by all the named inventors. The filing of a petition under 37 CFR 1.48(b) is not applicable prior to the application being executed by all the named inventors. Under 35 U.S.C. 363, an international application designating the United States has the effect of a national application for patent regularly filed in the United States. In other words, the U.S. national stage application is considered to have been filed on the international filing date in the names of the inventors/applicants for the United States of America listed on the Request form. The Request indicated Allen W. Thorpe, Edward W. Taylor, Jr., Rubin Feldman, and Malkit Deogon as applicants/inventors for the United States of America. MPEP 201.03 (page 200-10) states the following:

37 CFR 1.48(b) provides for deleting the names of persons originally properly included as inventors, but whose invention is no longer being claimed in a nonprovisional application. Such a situation would arise where claims have been amended or deleted because they are unpatentable or as a result of a requirement for restriction of the application to one invention, or for other reasons. A petition under 37 CFR 1.48(b) to delete an inventor would be appropriate prior to an action by the examining group where it is decided not to pursue particular aspects of an invention attributable to some of the original named inventors.

Accordingly, the requirements under 35 U.S.C. 371(c)(4) must be met, namely, that an oath or declaration of the inventors complying with the regulations for oaths or declarations of applications be filed. As set forth in 37 CFR 1.63, the oath or declaration must be executed by all the inventors.

CONCLUSION

For the above reasons, the petition under 37 CFR 1.48(b) is DISMISSED, without prejudice.

To avoid abandonment of this application, applicant must submit the following within two (2) months from the mail date of this decision: (1) an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), and (2) the surcharge for providing the oath or declaration later than 30 months from the priority date (37 CFR 1.492(e)). Extensions of time may be obtained under 37 CFR 1.136(a).

If the requirements of 35 U.S.C. 371(c)(4) are met, applicant may then file a petition under 37 CFR 1.48(b) to remove Malkit S. Deogon as an inventor.

Any further correspondence with respect to this matter should be addressed to the Assistant Director for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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